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EXAMINER


WINNER, TONY H

| ART UNIT | PAPER NUMBER |
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3611

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|-------------------------------------------------------------------------------------|
| Office Action Summary | Application No. 10/782,506 | Applicant(s) BERG ET AL. | |
| | Examiner Tony H. Winner | Art Unit 3611 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/18/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
Information Disclosure Statement

1. The following U. S. references, part of an IDS filed 6/16/04, are not being considered because the subject matter is not art relevance to the instant application; which teaches a heat shield for a snow mobile engine and a rider positioning in relation to the snowmobile so as to provide optimum riding experience.

- a. US. 6,230,836 – Aerodynamic design for vehicle,
- b. US. 6,250,411 B1 - 4WD power transmission for a vehicle,
- c. US. 6,263,991 B1 – Rear suspension for a snowmobile,
- d. US. 6,032,752 – Variable geometry suspension system,
- e. US. 5,769,040 – Two cycle internal combustion engine,
- d. US. 5,454,443 – Means for avoiding torsional vibration of the vehicle,
- f. US. 5,344,370 – Transmission for a vehicle,
- g. US. 5,103,943 – Vibration damper,
- h. US. 4,779,695 – Snowmobile seat construction,
- i. US. 4,699,234 – 4WD vehicle,
- j. US. 4,691,798 – System for preventing turnover of two wheeled vehicle,
- k. US. 4,502,353 – Reverse planetary transmission,
- l. US. 4,489,801 – Braking assembly for snowmobile,
- m. US. 4,423,795 – Wheeled vehicle with cambering front module,
- n. US. 3,981,372 – Unitary transmission of snowmobile,
- o. US. 3,908,483 – Planetary reverse transmission,
- p. US. 3,850,050 – Continuous variable automatic transmission,

- q. US. 3,474,751 – Amphibious snow vehicle,
- r. US. 2,504,243 – Control for internal combustion engine,
- s. US. 2,169,652 - Internal combustion engine,
- t. US. 2,084,080 – Engine mounting,
- u. US. 1,986,630 – Two cycle internal combustion engine,

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the movable handlebar of claims 4 and 43 must be shown or the feature canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "**The present invention relates generally to,**" "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

4. Claims 40 and 80 are objected to because of the following informalities: the recitation “the cylinder bore” should be changed to – a cylinder bore – so as to clearly distinct the cylinder bore structure from the cylinder bore axis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-22, 24-39, 46-62, 64-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 6, 11-15, 19-22, 24-25, 33-34, 46, 51-54, 59-62, 64-65, and 73-74, it is unclear as the functional language not clearly identify the rider's positions so as to achieve what is being claimed. For example: claim 6 recites “the first radius is less than a kneecap height of a pre-selected snowmobile rider” is unclear because the kneecap height of a pre-selected rider will varies depending on the placement of the rider' foot in combination with body position.

With regard to claims 39 and 79, the recitation “a cylinder bore axis of the engine is directly rearwardly and upwardly” is unclear and confusing. The cylinder bore axis is directly rearwardly and upwardly of what?

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-22, 24-38, 46-62, and 64-78 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In the instant application, a person is being claimed in combination with the snowmobile.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 6, 11-14, 19-25, 30-34, 39, 41-43, 45-46, 51-54, 59-65, and 70-74, (as best understood) are rejected under 35 U.S.C. 102(e) as being anticipated by Atsuumi (US. Patent 6,510,912 B1)

Atsuumi discloses a snowmobile comprising:

- a. a frame (32);
- b. a drive including an engine connected to the frame and a drivetrain

operatively coupling the engine to a drive track (figure 2);

- c. the drive being disposed within an imaginary cylinder extending laterally through the snowmobile (figure 2),
- d. the imaginary cylinder having an axis and a first radius (figure 1),
- e. a first control point of the snowmobile being disposed at a second radius from the axis of the imaginary cylinder.

With regard to claims 2-3, 5, 6, 11-14, 19-25, 30-34, 39, 42-43, 45-46, 51-54, 59-65, and 70-74 (figure 1) Atsuumi discloses all of the claimed limitations.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atsuumi in view of Marier (US. Patent 4,688,817).

Atsuumi is disclosed above but lacks the handlebar with a second position control point for the snowmobile.

Marier discloses a snowmobile with a handle bar comprises more than one control point so as to provide the user with the maximum convenience and safety.

Based on the teaching of Marier, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the handlebar of Atsuumi to

include more than one control point for the handlebar of Marier so as to provide the user with the maximum convenience and safety.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 2, 3, 5, 23, 40, 42, 43, 45, 63, and 80-90 are rejected under the judicially created doctrine of double patenting over claims 1-29 of U. S. Patent No. 6,796,395 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claims 2, 3, 5, 23, 40, 42, 43, 45, 63, and 80-90 of the instant application is identical to claims 1-20 of U.S. patent 6,796,395.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Allowable Subject Matter

11. Claims 40 and 80 would be allowable if rewritten to overcome the 35 USC. 102e rejection and double patenting rejection, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Claims 81-90 would be allowed if over come the double patenting rejection, set forth in this Office action.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ashida ('323), Chen et al. ('720), Pirchl ('177), Dudley ('932), Bonde et al. ('013), Rose ('287), and Parsons ('716) are cited of interest.

14. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Anthony H. Winner whose telephone number is (703) 306-5957. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris, can be reached at (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 3611

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



TONY WINNER
PATENT EXAMINER

September 16, 2004